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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,736	03/07/2006	Carsten Schellenberg	CO2522947/APCT	8745
324	7590	09/08/2009		
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			EXAMINER MULCAHY, PETER D	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			09/08/2009 ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/570,736

**Applicant(s)**

SCHELLENBERG ET AL.

**Examiner**

Peter D. Mulcahy

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8-18 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12, 20, 21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The term "obtainable" in claim 12 renders the claims indefinite. This term does not limit the claims in that it merely indicates that the powder can be formed from vaporizing the volatile components. This does not limit the claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 8, 9, 12-18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heger et al. US 6,531,117 alone or further in view of Weier et al. US 2002/0045681.
6. The rejection set forth under 35 USC 103 over Brenner et al. in the action mailed 1/21/09 is herein withdrawn. Applicant's remarks and claim amendments have obviated this rejection.

7. The claims instantly rejected are directed to a polymer dispersion comprising the polymer carrier and the UV stabilizer. The dispersion as instantly claimed, is considered a product. There are claim limitations directed to polymerizing the polymer carrier in the presence of the non-polar light stabilizer. This claim is considered a product-by-process claim. Case law has well established that the patentability of product-by-process claims is determined by the product limitations and not the process steps.

8. The Heger et al. patent shows aqueous dispersions based on carrier polymers and having non-polar light stabilizers added thereto, see the polymers listed at columns 3-4 and the light stabilizers listed at column 6 lines 3+. The claimed particle sizes are discussed at column 2 lines 0-64. The difference between the claimed invention and the cited art is the relative amount of stabilizer to polymer of greater than 100 parts stabilizer to 100 parts polymer is not expressly discussed. The amount of stabilizer is discussed at column 2 lines 50-58. Here, amounts of stabilizer of 70% are discussed. The amount of polymer is discussed at column 5 lines 3-14. Here, the minimum amount of coating polymer is 0.1% and the minimum amount of optional matrix polymer is 0.1%. This is seen to suggest compositions wherein the relative amount of stabilizer to polymer is greater than 100 parts stabilizer to 100 parts polymer. As such the claims are rendered *prima facie* obvious.

9. In the event that the process limitations can be read into the claimed product, the claims are rendered obvious by the combination of Heger et al. and Weier et al.

10. The Weier patent is seen to suggest aqueous dispersions of polymers and UV stabilizers, [0093], [0115], [0122] and [0128]. This patent further teaches the use of micro-emulsion techniques [0132] and polymerizing the monomers in the presence of the UV stabilizers [0143]. One of ordinary skill in the art would find it obvious to formulate the dispersion of Heger following the "in-situ" polymerization system of Weier. One would be motivated to formulate the dispersion of Heger using the polymerization system of Weier given the art recognized advantages of efficiency and cost saving when the elimination of steps is available.

11. Claims 10 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Heger et al. US 6,531,117 in view of Weier et al. US 2002/0045681.

12. These claims are process claims that positively set forth the process step of polymerizing in the presence of the UV stabilizer.

13. The Heger et al. patent shows aqueous dispersions based on carrier polymers and having non-polar light stabilizers added thereto, see the polymers listed at columns 3-4 and the light stabilizers listed at column 6 lines 3+. The claimed particle sizes are discussed at column 2 lines 0-64. The difference between the claimed invention and the cited art is the relative amount of stabilizer to polymer of greater than 100 parts stabilizer to 100 parts polymer is not expressly discussed. The amount of stabilizer is discussed at column 2 lines 50-58. Here, amounts of stabilizer of 70% are discussed. The amount of polymer is discussed at column 5 lines 3-14. Here, the minimum amount of coating polymer is 0.1% and the minimum amount of optional matrix polymer is 0.1%. This is seen to suggest compositions wherein the relative amount of stabilizer to

polymer is greater than 100 parts stabilizer to 100 parts polymer. Heger fails to suggest the "in-situ" polymerization process as claimed.

14. The Weier patent is seen to suggest aqueous dispersions of polymers and UV stabilizers, [0093], [0115], [0122] and [0128]. This patent further teaches the use of micro-emulsion techniques [0132] and polymerizing the monomers in the presence of the UV stabilizers [0143]. One of ordinary skill in the art would find it obvious to formulate the dispersion of Heger following the "in-situ" polymerization system of Weier. One would be motivated to formulate the dispersion of Heger using the polymerization system of Weier given the art recognized advantages of efficiency and cost saving when the elimination of steps is available.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter D. Mulcahy/  
Primary Examiner, Art Unit 1796